

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-26 are now present in this application. Claims 1, 8, 15, 19, 24, 25 and 26 are independent.

Amendments have been made to the Title, Abstract of the Disclosure and specification, claim 2 has been canceled, claims 24-26 have been added, and claims 1, 3-5, 9-19, and 21-23 have been amended. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

Priority Acknowledgement

The Examiner has not acknowledged Applicant's claim for foreign priority under 35 U.S.C. §119 on the form PTO-326, Office Action Summary, and incorrectly states on page 2 of the Office Action that the certified copy of the priority document has been filed in the parent application.

Applicant respectfully submits that there is no parent application and the alleged parent application is not available on the USPTO web site.

Withdrawal of this incorrect acknowledgement and a correct acknowledgement of Applicant's claim for priority and of submission of a certified copy of the priority application is respectfully requested in the next Office Action.

Title of the Invention

Applicant has amended the Title of the Invention in order to better reflect the subject matter claimed.

Abstract of the Disclosure

Applicant has amended the Abstract of the Disclosure in order to place it in better form.

Specification Objection

The Examiner has objected to the specification because "it is replete with grammatical and idiomatic errors." Applicant has amended the specification in order to correct two obvious informalities. Support for the changes is found in the drawings, Fig. 5, for example. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Objections

The Examiner has objected to claims 5-7, 10-11, 13-15, 22 and 23 because of several informalities. In order to overcome this objection, Applicant has amended the claims in order to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Objections

Claims 5-7, 10, 11, 13-15, 22 and 23 stand objected to. This objection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language lacks antecedent basis.

In order to overcome this objection, Applicant has amended claims 1 and 5 to correct each of the deficiencies specifically pointed out by the Examiner. Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Obviousness-Type Double Patenting Rejection

Claims 1 and 5 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2, respectively, of pending U.S. Patent Application Serial No. 09/899,066. This rejection is respectfully traversed.

The factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness-type double patenting analysis are missing from the Office Action with respect to independent claims 1 and 5.

Because the rejection is based on 35 USC §103, what is in issue in such a rejection is "the invention as a whole", not just a small part of the preamble of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). By failing to address all of the features of claims 1 and 5, the rejection fails to evaluate the invention as a whole and the rejection is improper and should be withdrawn.

Moreover, as pointed out in MPEP 804, because the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when

making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Applicant respectfully submits that a *prima facie* case of double patenting has not been established because the Office Action fails to point out the

differences between claim 1 of this Application and claim 1 of the '066 Application, or to point out the differences between claim 5 of this Application and claim 2 of the '066 Application. All that is provided is a statement of similarities between those claims.

Moreover, no statement of why the unspecified differences between the claims 1 and 5 of this Application and the '066 Application are obvious variations, respectively, of claims 1 and 2 of the '066 Application is presented in the rejection.

Additionally, Applicant has amended claims 1 and 5 of this Application and has amended claims 1 and 2 of the co-pending '066 Application, so that this rejection is moot with respect to the Amended claims. Amended claims 1 and 5 positively recite, among other features, dividing the digital image into plural cell regions, a feature not found in claims 1 or 2 of co-pending Application Serial No. 09/899,066.

Moreover, no objective evidence of such a feature is presented in the rejection.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 1-4, 8-11, 15 and 19-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,038,216 to Easterly et al. (hereinafter, "Easterly"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, the rejection is moot with respect to claim 2, which has been canceled.

Independent claims 1, 8, 15 and 19 are not anticipated by Easterly. Claim 1 recites a number of steps including switching a photographing mode of a camera. Easterly does not perform the claimed invention. Easterly is directed to obtaining automatic color balancing of color photographic images for subsequent display on a color monitor in a film-to-video transfer system. See the preamble of claim 6 of Easterly, for example, and col. 4, lines 10-64, for example. Easterly does not disclose switching a photographic mode of a camera in any manner whatsoever.

The Office Action alleges that the switching of a photographic mode based on the comparison of illumination levels is disclosed in col. 4, lines 52-59 and in col. 33, lines 24-28.

However, col. 4, lines 52-59 of Easterly merely discloses details of an apparatus, including a variable aperture, that automatically controls brightness of an optical image that is translated into digital samples. There is no disclosure

of switching the mode of a camera.

In col. 33, lines 24-28, which are part of Easterly's claim 1, the automatic brightness control, including means to vary an aperture, is claimed. There is no disclosure of switching the mode of a camera, here, either.

Moreover, because claims 3 and 4 depend from claim 1, claims 9-11 depend from claim 8, and claims 20-21 depend from claim 19, dependent claims 3, 4, 9-11, 20 and 21 are not anticipated by Easterly.

Reconsideration and withdrawal of this rejection of claims 1-4, 8-11, 15 and 19-21 is respectfully requested.

Claims 1, 5, 8 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,172,220 to Beis. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Beis does not anticipate claims 1, 5, 8 and 12. Claims 8 and 12, as amended, recite a combination of features, including dividing the photographing area into a plurality of cell regions, detecting an illumination level of each cell region and switching the photographing mode of the camera on the basis of the detected illumination levels of the plurality of cell regions.

Beis switches from a daytime mode to a nighttime mode based on ". . . a light sensitive switch, e.g., a twilight switch, which is activated when the intensity

of the incoming light reaches a threshold value. Alternatively, the magnitudes of the electrical signals or image signals can be used.” – see col. 2, lines 30-36. “

However, Beis does not disclose or suggest a combination of features, including detecting an illumination level of each cell region; and switching the photographing mode of the camera on the basis of determining whether the detected illumination level of each cell region is higher than a previously determined standard illumination level, as recited.

With respect to claims 1 and 5, Beis does not disclose or suggest the claimed combination of features including, for example, “dividing the digital image data into plural cell regions; comparing the detected illumination levels for each cell region to a previously determined standard illumination level; and switching a photographing mode of a camera on the basis of the comparison result,” as recited.

Reconsideration and withdrawal of this rejection of claims 1, 5, 8 and 12 is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 6, 7, 13-19, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 5,038,216 to Easterly. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office

Action, and is not being repeated here.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker,

977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made.

However, these inquiries are not found in this rejection.

Beis does not disclose the invention recited in independent claims 1 and 8 at least for the reasons stated above. Easterly does not disclose the features recited in independent claims 1, 8, 15 and 19, at least for the reasons stated above.

Applicant respectfully submits that the discussion of Beis on page 9 of the rejection is incomplete and misleading. The “twilight switch” of Beis is discussed

above, and is used by Beis to decide when to switch from a daylight mode to a nighttime mode. Beis discloses an embodiment in which he uses a single detector with different sensing elements for black and white and different sensing elements for color. No specific detector patterns are disclosed. Moreover, Beis discloses using "the magnitudes of the electrical output signals or image signals can be used" as the twilight switch. No details of how the image signals are used are presented.

Beis simply does not disclose the specific features positively recited in independent claims.

The Office Action then turns to Easterly, which has nothing to do with switching between a daytime photographing mode and a nighttime mode of operation of a camera, but is directed to a device that automatically balances the colors in an image being transferred from film to video from a photographic medium to an electronic medium.

The Office Action alleges that Easterly teaches "that a camera may switch to a low light intensity mode when the number of cell regions having a lower illumination level than the standard illumination level is greater than a certain percentage of the total number of cell regions, referencing col. 18, lines 64-70 and col. 33, lines 31-34.

Applicant disagrees.

Col. 18, lines 64-70 of Easterly concerns scanning a transparency and providing maximum pixel values. Col. 33, lines 31-34 of Easterly recite a means to

open an aperture through which an image is transmitted for digitization.

The Office Action then speculates that “providing in Beis a statistical method for considering the illumination of the plurality of cell regions” would make the determination to switch modes more robust by factoring in all available illumination information.

There is no objective evidence provided for this speculative general assertion and it just appears out of nowhere.

Then, based on this speculative general statement, the Office Action concludes that it would be obvious to use the statistical method of Easterly to modify Beis in order to make the mode-switching decision accurately.

Applicant respectfully submits that the Office Action fails to meet its burden of demonstrating proper motivation for one of ordinary skill in the art to modify Beis as proposed.

In the first place, the Office Action does not address the fact that Beis and Easterly are concerned with distinctly different problems, and that they function differently. Beis discloses a surveillance camera with a fixed lens that has a simple twilight switch to switch between a daytime mode and a nighttime mode of operation. Beis has no disclosure of a need to modify its twilight switch. Beis also does not disclose (as admitted in the rejection) counting the number of cell regions having a lower illumination level than the standard illumination level and

determining whether the counted number is greater than a certain percentage of the total number of cell regions.

In the second place, Easterly contains no disclosure of (1) a surveillance camera, (2) a daytime mode of operation and a nighttime mode of operation; (3) a switch to switch between the daytime mode of operation and the nighttime mode of operation.

In the third place, the Office Action fails to provide objective evidence that one of ordinary skill in the art would desire to modify a surveillance camera like that of Beis with a film to video transfer system, especially a certain part of that system that has to do with properly balancing colors in an image being transferred from film to an electronic medium. Beis has no such feature or a need for such a feature.

The mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggested the desirability of the modification.

All that is presented in terms of motivation is the alleged desirability of providing a statistical method of Easterly's color balancing system to Beis. However, this statement is nothing more than a broad, conclusory speculative statement that, standing alone, is not evidence of motivation to modify Beis and provide Beis with such a system. See In re Dembiczak, cited above, in this regard.

Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). No such objective evidence is presented. All that is presented is a speculative generalized statement that does not constitute a clear particular motivation to combine such disparate references. Accordingly, the motivation for modifying Beis to include the claimed features must be based on speculation and/or impermissible hindsight.

Reconsideration and withdrawal of this rejection of claims 6, 7, 13-19, 22 and 23 is respectfully requested.

New Claims

Claims 24-26, which are device/apparatus claims that correspond to claims 1, 8 and 15, have been added. Claims 24-26 are deemed patentable over the applied art for the reasons that claims 1, 8 and 15, which recite similar method steps are patentable over the applied art, for reasons stated above.

Accordingly, consideration and allowance of claims 24-26 is respectfully requested.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

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Art Unit 2615

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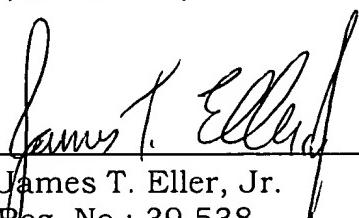
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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JTE/RJW/adt

Attachment: Abstract of the Disclosure